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09/469,633	12/22/1999	MICHAEL T. WHITE	F19-99-140	5198

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INTERNATIONAL BUSINESS MACHINES CORPORATION
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EXAMINER

ZEENDER, FLORIAN M

ART UNIT PAPER NUMBER

3627

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/469,633
Filing Date: December 22, 1999
Appellant(s): WHITE ET AL.

MAILED
APR 05 2004
GROUP 3600

Jay H. Anderson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/26/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because claims 1-3 are not separately patentable from claim 7. The method step limitations of claim 1 are of similar scope to the "automated method" steps of claimed 7 and to store the method steps of claim 1 on a computer-readable medium would have been obvious to one of ordinary skill in the art as it is well known that an "automated system" often uses computers.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,101,481	Miller	8-2000
4,937,743	Rassman et al.	6-1990

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 12/29/2003.

(11) Response to Argument

Under heading "A":

The Applicant summarizes the teachings of Miller and Rassman et al. The Examiner agrees with this summary, however in the last three lines of page 6, the Applicant states that it should be noted that for Rassman et al., the term "conflicts" is used to indicate a lack or imbalance of resources, as opposed to misuse of the system or fraud. The Examiner notes that the terminology, "misuse of the system or fraud" is **not claimed** in any of claims 1-3 and 7. Rather, the claims use the language, "incompatible transactions" which language **is** anticipated by the term "conflicts" used in Rassman et al.

Under heading "B":

The Examiner agrees with the Applicant's remarks. *It should be noted that the Examiner's use of Official Notice is substantiated by the Applicant's own admission of*

prior art in the "BACKGROUND OF THE INVENTION" (See specification, page 1, line 21 through page 2, line 9).

Under heading "C1":

The Examiner agrees with the Applicant's statements regarding the requirements for a rejection under 35 U.S.C. 103(a). The Examiner has met the requirements when taking into account the Examiner's statement of Official Notice.

Under heading "C2":

The Examiner agrees that the references alone do not teach specific limitations, but it is the combination of references in light of the Examiner's statement of Official Notice that anticipates the limitations of the claims. The Miller reference generally teaches that it is well known to automate a security process (See more specifically Miller, Col. 3, line 25 through Col. 4, line 19 and the Office Action mailed 12/29/03). Rassman generally teaches that it is well known to have an automated system that identifies conflicts and notifies relevant personnel of the conflicts (See more specifically, Rassman, Col. 3, lines 19-32; and the Office Action mailed 12/29/03).

Under heading "C3":

The appellant argues that there is a lack of motivation to combine Miller and Rassman et al. because Rassman et al. views people as resources and "Miller teaches that it is not desirable for people to be viewed as resources". However, this argument is not persuasive because the Rassman et al. reference teaches that its system can be used for other resources such as equipment (See, for example, Rassman et al. Col. 12, lines 14-24).

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In the last paragraph of page 9, the applicant argues the combination of Miller and Rassman et al. only. The Examiner agrees that Miller in view of Rassman et al. alone do not teach the limitations of the claims.

In the first full paragraph of page 10, the Appellant admits that "Business Conduct Guidelines" are well known and that creating a list of incompatible transactions manually from the guidelines is well known. In the second full paragraph of page 10, the Appellant states (and does not contest) that the Examiner suggests it would be obvious to monitor employee compliance with the incompatible transactions in accordance with the conduct guidelines. The Appellant, however, states that it is not obvious how this may be done in an automated system and states that computer systems are used "so that no physical or clearly visible trail leads back to the employee performing the transaction.

The Examiner disagrees that it is not obvious. The Miller reference specifically teaches that it is well known to use computer systems (See Miller Col. 4, line 2) for security-type tasks whereby no physical trail (i.e., no paper trail) is necessarily generated. The Rassman et al. reference teaches that computers are known to generate automatic reports of conflicts (Rassman et al., Col. 3, line 19-25).

At the top of page 11, the Appellant argues that the prior art does not provide the necessary motivation to include business conduct guidelines or comparison of security profiles with lists of incompatible transactions. However, the prior art provides motivation for automating security systems (See for example, Miller Col. 3, lines 25-30), and applicant's claims are for a security-type system.

Under headings "C4" and "C5":

Applicant again argues that the prior art lacks an automated process having the necessary limitations of claim 7.

The Examiner agrees that the references alone do not teach specific limitations, but it is the combination of references in light of the Examiner's statement of Official Notice that anticipates the limitations of claim 7. The Miller reference generally teaches that it is well known to automate a security process (See more specifically Miller, Col. 3, line 25 through Col. 4, line 19 and the Office Action mailed 12/29/03). Rassman generally teaches that it is well known to have an automated system that identifies conflicts and notifies relevant personnel of the conflicts (See more specifically, Rassman, Col. 3, lines 19-32; and the Office Action mailed 12/29/03).

The Appellant then argues that there is no motivation to combine the prior art. However, the Examiner has provided motivation in his Office Action mailed 12/29/03 which is "to provide a cost efficient system". This motivation is precisely why businesses automate certain processes. The Rassman et al. reference has been used by the Examiner to teach that it is well known to provide automated reports to relevant personnel of business conflicts.

The prior art provides motivation for automating security systems (See for example, Miller Col. 3, lines 25-30), and applicant's claims are for a security-type system. The simple automation of an obvious security process is not patentable in view of the prior art.

For the above reasons, it is believed that the rejections should be sustained.

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F. RYAN ZEENDER
PRIMARY EXAMINER

Respectfully submitted,



Florian (Ryan) Zeender
August 2, 2004

Conferees:

Lynda Jasmin *L.J.*

Joseph Thomas *J.T.*

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